

REMARKS

Claims 1-20 are pending in this application. Claims 15 and 20 are amended in several particulars for purposes of clarity in accordance with current Office policy, to assist the examiner and to expedite compact prosecution of this application.

I. Claim Objections

The Examiner stated that claims are objected to because of the following informalities:

Claim 15, line 1, "The method of claim 1," should be deleted; and

Claim 20, line 3, "a display" should be -- said display --.

The claims have been amended accordingly.

II. Claim Rejections - 35 USC § 103

According to MPEP 706.02(j), the following establishes a *prima facie* case of obviousness under 35 U.S.C. §103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

A. Claims 1-12 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida Japanese Patent Application No. 6-261224 in view of Nishida et al. U.S. Patent No. 6,972,858 (hereinafter Nishida). The Applicant respectfully traverses.

With respect to claims 1 and 8, the Examiner states that Yoshida teaches a method for controlling transmission of fax data according to a data output order of a facsimile receiving part (claims 1 & 4 in pages 5-6), the method comprising the steps of:

scanning and storing a document into data to be transmitted from a facsimile transmitting part to said facsimile receiving part (claim 4);

dialing a predetermined telephone number of said facsimile receiving part (paragraph 32),

requiring and receiving said data output order by said facsimile transmitting part from said facsimile receiving part after the telephone number of said facsimile receiving part is dialed (claim 4 & paragraph 39); and

transmitting by said facsimile transmitting part, said stored document data in the same order as said received data output order (claim 4).

The Examiner states that Yoshida, however, does not explicitly teach that the predetermined telephone number of said facsimile receiving part is dialed when said document is completely scanned.

Examiner notes that it would have been obvious to one of ordinary skill in the art to dial the receiving part after the scanning operation since the scanned document needs to be sorted/rearranged for the appropriate transmission based on the received data output order.

Further, the Examiner notes that Nishida, the same field of endeavor of facsimile transmission method, teaches a method of dialing a predetermined number of a receiving facsimile after the completion of a scanning operation (fig. 7).

The Examiner states that at the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the method of Nishida with the method of Yoshida.

The Examiner states that the suggestion/motivation for scanning the document before dialing would have been to sort/rearrange the transmitting order of the scanned document based on the received data output order.

1. However, as mentioned by the Examiner in the interview of 17 and 18 November 2005

and included in the interview summary on page 9 of the response of 21 November 2005, Yoshida (U.S. Patent No. 6,449,063) as applied for example to claim 1 fails to teach “transmitting the stored document data in the same order as the received data output order”. The Examiner suggested such an amendment for a request for continued examination and the Applicant in good faith filed the RCE with such amendment. Yoshida is the same reference that was being applied in the final rejection and now being applied again against the language that the Examiner suggested to be included. Therefore, we ask the Examiner to reconsider the rejection of the claims based on the Examiner’s suggestion of 17 and 18 November 2005 concerning Yoshida et al.

2. Yoshida fails to teach or suggest “transmitting the stored document data in the same order as the received data output order”. In Yoshida as mentioned in the abstract, the receiver recognizes whether information is transmitted from the first page or from the final page and changes the recording order accordingly and the transmitter recognizes whether the recording order and the transmitter recognizes whether from a face up or face down and changes transmission order. Therefore, Yoshida fails to teach or suggest transmitting by said facsimile transmitting part, said stored document data in the same order as said received data output order. Rather, Yoshida is only teaching whether the recording method on the receiver is face up or face down, which does not teach or suggest being in the same order.

The Examiner cites claim 4 of Yoshida and attaches a machine translation. However, all machine translations are problematic as even the Japan Patent Office warns that machine

translations have problems as evident by the choppy and often incoherent sentences in the Thomson machine translation.

In claim 4 of Yoshida, it is evident that the machine translation has problems for example the “purport” is actually the intention or purpose in Japanese. Claim 4 is basically reiterating generally the abstract about face up and face down transmission. The facsimile transmitter stores the information that the receiver cannot record face down and the transmitter will do memory transmission from next time and transmit from the last page of the document. However, this is not teaching transmitting by said facsimile transmitting part, said stored document data in the same order as said received data output order.

Further, the data output order is not taught or suggested to be sent from the transmitting part to the receiving part after dialing because Yoshida’s order is the same whether there is a single side printing or double sided printing. It’s only when there is an error in the printing that a blank page is avoided on a side. The order itself is not changed, but rather when there is an error, the back side is not printed on. As mentioned on col. 10, lines 54-57, always retransmitting from the front side at the same time of transmission of the both side document sheet as an error re-transmission. Yoshida helps in retransmitting of a transmission with an error without concern for the collation of the print.

Therefore, the both side and single sided printing is not actually a setting of the printing order itself as mentioned in col. 10, lines 41-45, when there is a both side print, it is sequentially transmitted and the one side document would be printed the same way, but not printed on the back

side. The actual printing order is not affected, rather in retransmission Yoshida does not force the reverse side to be printed on the front side. The reverse page is kept on the reverse page in the retransmission while the front page is kept on the retransmission. The present invention, however concerns the actual output order which is sent by the receiving part and received by the transmitting part after dialing.

In Yoshida, the output order remains the same which is still sequential.

Yoshida does not disclose transmitting the stored document data in the same order as the received data output order as seen in the amended claim 1. The data that is transmitted by Yoshida is not varied according to the order received, but when retransmitting, the front side is sent. The order of the output is never actually sent, but rather the output is varied when there is an error and a retransmission.

The Examiner assumed that the order is sent as the Examiner assumes no sorting, but no such teaching is actually made that no sorting is necessary. Rather the background and summary deals with after an error, the print is not improperly started on a different side. Therefore, actual collation of the print may still be necessary if printed different than the receiving part receives the paper as such is not taken into account by Yoshida.

3. With respect to claims 2 and 8, the Examiner states that Nishida teaches the method, further comprising the step of displaying the capabilities of the facsimile receiving part (col. 13, lines 8-14). However, looking at col. 13, lines 8-14 only shows that the IFAX *capabilities* are displayed

and not *displaying said data output order received from said facsimile receiving part, on said facsimile transmitting part* as claimed. The claim is not claiming capabilities as the Examiner suggests but the actual output order received. What one is capable of receiving and what one actually receives are two different things. Nishida defines capability as "The apparatus capability includes the linear density, print paper size, and the image coding system, which are necessary for facsimile communication." col. 10, lines 5-8 of Nishida. Therefore, clearly, Nishida fails to teach or suggest the claimed invention and Yoshida adds nothing further.

4. With respect to claim 6, the Examiner states that Nishida teaches the method, with said requiring of said document order being made during Phase B of a facsimile transmission, Phase B being a sequence of checking states of said facsimile transmitting part and a transmission line and controlling said facsimile transmitting part among a plurality of predetermined protocols used in transmission and reception of facsimile data (col. 9, line 51 - col. 10, lines 8).

However, col. 9, line 51 - col. 10, lines 8 of Nishida discusses part of step 704, 705 and figure 9 which does not teach of requiring of the document order during the phase B.

5. . With respect to claims 7 and 9, the Examiner states that Nishida teaches the method, with said dialing a predetermined telephone number of said facsimile receiving part being automatic (col. 9, lines 47-50).

Step 704 states in Nishida that the facsimile control section controls the telephone circuit according to the instruction command and call to the receiver side. This, however, is not teaching

automatically dialing a predetermined telephone number of the receiving part. In fact there is nothing remote in Nishida to automatic calling as controlling the telephone circuit according to instruction can be any number of variable possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient.” *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981). According to MPEP 706.02(j), an actual teaching or suggestion must be made in the references.

6. With respect to claim 8, the Examiner states that Yoshida teaches requiring a data output order by said facsimile transmitting part from said facsimile receiving part when said call is connected (claim 4 & paragraph 39).

However, as mentioned above, claim 4 only mentions what is already in the abstract and it does not teach the claimed limitation of requiring the data output order by the transmitting part from the receiving part when the call is actually connected as the call is not discussed in claim 4 of Yoshida. Paragraph 39 of Yoshida only discusses step S70-78 where there is output of a signal, a pre-procedure, and confirmation of whether a companion receiver can perform a face up recording and if not then a control action is performed. Nowhere is there a mention of the requiring data output order when the call is connected from and by the particular parts.

7. Concerning claim 8, the Examiner states that Yoshida teaches receiving said data output order by said facsimile receiving part from said facsimile transmitting part after said requiring of said data output order (claim 4 & paragraph 39).

However, both claim 4 and paragraph 39 fail to teach or suggest receiving the output order after requiring the order. Claim 4 of Yoshida does not make a requirement before the reception of the order.

8. With respect to claim 18, the Examiner states that Yoshida teaches the method, further comprising of selecting an advance-transmitting function to accommodate said requiring said data output order by said facsimile transmitting part from said facsimile receiving part when said call is connected (two different modes in claim 3).

However, claim 3 of Yoshida only states concerning when the transmitter reads the original document from the last page is in direct transmitting mode when notification of the purpose that cannot be performed face up is received at the receiver end. However, Yoshida is not teaching an advance-transmitting function to accommodate specifically *requiring* the data output order by the transmitting part from the receiving part when the call is connected.

9. With respect to claim 19, the Examiner states that the combination of Yoshida and Nishida teaches the method of claim 18, after the data output order of the facsimile data is displayed on a display of said operational panel, the facsimile data stored in a memory is then transmitted to said facsimile receiving part according to the displayed data output order. Refer to col. 13, lines 8-14 & fig. 8 of Nishida.

First, Nishida is displaying the capability which as defined above is not the data output order.

Moreover, there is no teaching that after the display then specifically the facsimile data in memory is then transmitted. Figure 8 does not teach such an order of the display of the actual output order and then the facsimile data stored being transmitted.

10. With respect to claim 20, the Examiner states that the combination of Yoshida and Nishida teaches the method of claim 8, further comprised of displaying said data output order when said data output order is received from said facsimile receiving part on said display on said operational panel. Refer to col. 13, lines 8-14 & fig. 8 of Nishida.

However, displaying the data output order *when* the data output order is actually received is not taught or suggested. The connection, of the receipt and then the display, is not made. Nishida only teaches displaying the capabilities which are not the actual output order itself.

B. Claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida in view of Nishida and in further in view of Bloomfield U.S. Patent No. 6,693,729. The Applicant respectfully traverses.

1. With respect to claim 13, the Examiner states that Yoshida discloses a facsimile transmitting part apparatus, comprising a memory storing said system program guiding said control unit, the digital image data from the document being stored in said memory before being transmitted to said facsimile receiving part by a transmission signal from said controller in the same order as the received document output order (claim 4);

The Examiner admits that the combination of Yoshida and Nishida, however, does not disclose expressly that the network control unit forms a communication loop of the public telephone network having a ring and a tip, but that Bloomfield discloses a facsimile communication system using a communication loop of the public telephone network having a ring and a tip capabilities (col. 4, lines 26-36).

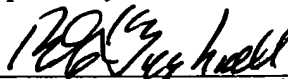
However, as mentioned above concerning claims 1 and 8, the Examiner had stated that Yoshida fails to teach or suggest a memory storing said system program guiding said control unit, the digital image data from the document being stored in said memory before being transmitted to said facsimile receiving part by a transmission signal from said controller in the same order as the received document output order. Bloomfield and Nishida do not teach or suggest such limitations.

In view of the foregoing amendments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the examiner is asked to contact the applicant's attorney.

A fee of \$120.00 is incurred by filing a petition for one-month extension of time. Applicant's check drawn to the order of the Commissioner accompanies this Amendment. Should there be a deficiency in payment, or should other fees be incurred, the Commissioner is authorized to charge

Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,



Robert E. Bushnell,
Attorney for the Applicant
Registration No. 27,774

1522 "K" Street, N.W., Suite 300
Washington, D.C. 20005
(202) 408-9040

Folio: P56056
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